Remarks

This Amendment is responsive to the Office Action of **July 14, 2004.** Reexamination and reconsideration of claims 1-25 is respectfully requested.

Summary of The Office Action

Claims 1-25 were provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 09/797,784.

Claims 1-25 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 09/797,784 in view of Shelton et al (U.S. Patent No. 5,954,798).

Claims 8 and 9 were rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-25 were rejected under 35 U.S.C. § 102(f) because the applicant did not invent the claimed subject matter.

Claims 1-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis et al. (US Patent No. 5,796,952), and further in view of Shelton et al. (US Patent No. 5,954,789).

Claims 1-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gartner et al (PGPUB No. US 2002/0124047 A1) and further in view of Shelton et al. (US Patent No. 5,954,789).

Double Patenting Rejection

Office Action Section 2 and 3

Common Ownership: The present application and co-pending application No. 09/797,784 were, at the time the invention of the present application was made, owned by the Hewlett-Packard Company or subject to an obligation of assignment to the Hewlett-Packard Company. Therefore, both inventions were and are commonly owned. In accordance with MPEP 706.02(l)(2), this is sufficient evidence to disqualify co-pending application No. 09/797,784 as prior art and from being used in a rejection under 35 U.S.C. 103(a).

A terminal disclaimer in compliance with 37 CRF 1.321(c) is also included with the present response. Therefore, the non-statutory double patenting rejection and the provisional rejection under 35 U.S.C. 103(a) should be withdrawn.

Office Action Section 4

The Examiner has stated that the assignee is required to state which entity is the prior inventor of the conflicting subject matter of co-pending application No. 09/797,784. Applicant believes, based on 37 CFR 1.78(c), this is not required since the present response states that the inventions were commonly owned or were subject to an obligation of assignment to the same entity at the time the later invention was made. Thus, the issue of priority is moot.

Office Action Section 5

In view of the common ownership between the present application and the co-pending application No. 09/797,784 as stated previously, the co-pending application is disqualified as prior art. Therefore, the provisional rejection based on obviousness-type double patenting should be withdrawn.

Objections to the Specification

Office Action Section 6

The Office Action states that the multiple mentions of "Flash" in the specification should be corrected to mean, "Flash memory." Applicant believes correction is not necessary because the specification states, on page 4, lines 18-19, "It includes a processor 110, memory 112 (e.g., ROM, RAM, CD-ROM, Flash, disk, etc.)" and on page 5, line 11, it states, " ...memory 122 (e.g., ROM, RAM, Flash,...)" Thus, it is clear that "Flash" is a memory since it is an example of memory 112 and memory 122, respectively.

Office Action Section 7

The title was objected to for not being descriptive. The Applicant appreciates the Examiner's suggestion but does not believe that changing the word "user" to "session" provides additional benefit under MPEP 606.01. Applicant believes the present title fully complies with MPEP 606.01, is descriptive, and provides informative value in indexing, classifying, searching, etc.

Non-Art Claim Objections and Rejections

Office Action Section 8

The typographical errors identified in claims 5 and 20 have been corrected in the present amendments.

Office Action Section 9

Claims 8 and 9 were rejected under 35 U.S.C. 112, second paragraph for being unclear with regard to the phrase "collecting multiple time to display results." Applicant believes this phrase is clear in view of claim 8 or 9 as a whole. For example, claim 8 recites "deriving a time to display result..." where the term being derived is "a time to display result." The phrase in question simply recites the plural form of the term as collecting multiple "time to display results." Claim 9 uses similar terminology. Therefore, claims 8 and 9 are clear and comply with 35 U.S.C. 112, second paragraph requirements.

Claim Rejections

Office Action Section 10

Claims 1-25 were rejected under 35 U.S.C. § 102(f) because the applicant did not invent the claimed subject matter based on commonly owned, co-pending application no. 09/797,784. Applicant respectfully asserts that the present claims do not recite the same invention as in co-pending application no. 09/797,784. Similarities between the two applications are not sufficient to support a §102(f) rejection. Each of the present independent claims includes limitations not taught by the co-pending application. Therefore, the §102(f) rejection is not supported and should be withdrawn.

Office Action Section 11

Claims 1-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis et al. (US Patent No. 5,796,952), and further in view of Shelton et al. (US Patent No. 5,954,789).

Independent Claim 1

Davis fails to teach or suggest the elements of claim 1, as indicated in the Office Action, for at least the following reasons. Overall, Davis teaches an advertising tool that determines interests of users to facilitate serving targeted advertising to those users (column 1, lines 61-64). Davis has nothing to do with document render times and/or with determining or processing document render times as in the present application. It is clear from reading Davis that the time a user displays a page is completely different from the time is takes to render a page.

For example, Davis is directed to a method for monitoring the amount of time a client spends interacting with and displaying a file downloaded from a server (see Abstract and Summary). The purpose of Davis' invention is to be able track user preferences and to serve out marketing information on a targeted basis (column 2, lines 48-55). The Office Action (on page 7, first sentence) cites column 4, lines 46-48 in the Davis patent for teaching a tracking program, which is used page 8 of the Office Action to suggest the elements of claim 1 with respect to deriving a document render time.

When reading the entire sentence that describes the tracking program (starting at column 4, line 46), the Davis patent states, "The tracking program is downloaded from a server and runs on the client to monitor various indicia, such as elapsed time...in order to track the user's interaction with and use of the file or to monitor choices (such as selections or links to other resources or files) made by the user while within the file." The description is clear that the tracking program operates while the user is within the file and tracks what the user is doing when interacting with the file. This has nothing to do with document render times and Davis has no concern for how long it takes for a document, page, file, or other object to be rendered.

One of ordinary skill would find no relationship between a document render time and the purpose of the tracking program taught by Davis. Davis provides no teaching or suggestion that a document render time is to be monitored. Even though the tracking program may execute upon the occurrence of a predetermined event, it would not be obvious that "this event could include the rendering of the requested document on the client side" (Office Action, page 8).

Applicant finds no suggestion that would motivate one of ordinary skill in the art to modify Davis in this manner. Generally speaking, any program can be made to execute on any event. But, this generic statement from Davis does not supply the necessary teaching or suggestion to form a proper §103 rejection. If the analysis of the present §103 rejection were valid, then Davis would make obvious every monitoring system. This is, of course, not true and is not supported by the requirements of §103.

It is only by using impermissible hindsight that the Office Action comes to the conclusion that the Davis patent makes obvious the rendering time of a document and the specific elements recited in claim 1. Only by reading the present application would one of ordinary skill learn about the present systems and methods, and about the particular method recited in present claim 1. Therefore, Davis fails to teach or suggest the elements associated

with document render times as recited in claim 1. The other combined reference, Shelton, fails to cure these shortcomings. Thus, the §103 rejection should be withdrawn.

Based on the above discussion, present claim 1 is not taught or suggested by the references, individually or in combination. For example, Davis fails to teach or suggest serving the document along with a time stamp and an executable script to the client and the script being configured to return the time stamp when the document is rendered on the client as recited in claim 1. As stated previously, Davis teaches a system that monitors preferences and interests of a user when interacting with a file, which has no relation to returning a time stamp when a document is rendered.

Claim 1 further recites deriving a document render time from the time stamp. Davis is only interested in user preferences for advertising purposes and fails to teach or suggest deriving a document render time. Claim 1 further recites logging the document render time and determining an average render time. Since Davis fails to suggest deriving a document render time, it follows that Davis also fails to teach or suggest the logging and determining elements of claim 1. Modifying Davis to include the session ID taught by Shelton still fails to teach or suggest all the elements of claim 1.

Since claim 1 recites features not taught or suggested by the references, individually or in combination, claim 1 patentably distinguishes over the references. Accordingly, dependent claims 2-6 also patentably distinguish over the references and are in condition for allowance.

Furthermore, dependent claims 3-6 include additional limitations associated with processing a document render time, which are not taught or suggested by the references. For these additional reasons, claims 3-6 patentably distinguish over the references.

Independent Claim 7

Claim 7 recites, for example, ascertaining a metric representative of an average time to display requested information as a function of the values received for the session. Based

on the discussion above, Davis fails to teach or suggest ascertaining the metric as claimed. Davis provides no suggestion about determining display times of information and thus fails to suggest the claimed ascertaining.

It further follows that Davis fails to teach or suggest sending responses to the client, each response containing a value and an executable program, where the value is used to ascertain the metric representative of an average time to display information. Using the teachings of Shelton, the teachings still fail to cure the shortcomings of Davis.

Since claim 7 recites features not taught or suggested by the references, individually or in combination, claim 7 patentably distinguishes over the references. Accordingly, dependent claims 8-10 also patentably distinguish over the references and are in condition for allowance.

Furthermore, dependent claims 8-10 include additional limitations associated with processing a time to display result, which are not taught or suggested by the references. For these additional reasons, claims 8-10 patentably distinguish over the references.

Independent Claim 11

Claim 11 recites, for example, ascertaining an average render time per unique user session as a function of the values received for the clients. Based on the teachings of Davis, Davis fails to teach or suggest this claimed element. As such, Davis also fails to teach or suggest the sending and receiving elements of claim 11 that process values used to ascertain the average render time. Therefore, claim 11 recites elements not taught or suggested by the references, individually or in combination. Thus, claim 11 patentably distinguishes over the references.

Independent Claim 12

Contrary to the Office Action's conclusion on page 13, it would not be obvious to a person of ordinary skill in the art to interpret Davis as teaching the claimed time-to-render monitor to determine an average render time based on returned time values. Although the

tracking program of Davis can be triggered by a variety of events, nothing suggests that the tracking program can be modified to be a time-to-render monitor that determines an average render time as claimed.

Determining average render times is a function that has no association with and is independent from initiating a program using a predetermined event. Thus, the reasoning of the Office Action on page 13 is overreaching and cannot support a valid obviousness rejection. Furthermore, all web pages are rendered and that is how the process is described in the art. Thus, since Davis generically mentions rendering of a web page and nothing more, that statement provides no suggestion or motivation to one of ordinary skill to modify Davis in a way to create a component that determines average render times such as the time-to-render monitor or the other recited elements of claim 12.

Davis, in column 8, line 64 to column 9, line 10, describes what the tracking program monitors. It monitors the length of time the user remains in a web page, keyboard events, and the amount of time the web page is displayed on the client computer. There is no suggestion for determining an average render time for a page because Davis is not concerned with determining render times. Render times relate to system performance and are not related to user interests for marketing advertisements and are not related to how long a user displays a page for viewing.

Therefore, claim 12 recites elements not taught or suggested by the references, individually or in combination. Thus, claim 12 patentably distinguishes over the references. Accordingly, dependent claims 13-16 also patentably distinguish over the references and are in condition for allowance.

Independent Claim 17

Claim 17 recites a server module and a render time measurement module that derives an average document render time. Based on the teachings of Davis described above, Davis fails to teach or suggest any component associated with deriving an average document render

time. Davis is not concerned with such a feature and there is no motivation to modify Davis to have such a feature.

Therefore, claim 17 patentably distinguishes over the references, individually or in combination. Accordingly, dependent claims 18-22 also patentably distinguish over the references and are in condition for allowance.

Independent Claim 23

Claim 23 recites a computer-readable medium having computer-executable instructions that direct one or more computing devices to, for example, derive a document render time and determine an average document render time. As explained previously, Davis provides no teaching or suggestion of features relating to deriving a document render time or average document render time. Therefore, Davis even when combined with Shelton, does not teach the claimed computer-readable medium of claim 23.

Since claim 23 recites features not taught or suggested by the references, individually or in combination, claim 23 patentably distinguishes over the references. Accordingly, dependent claims 24-25 also patentably distinguish over the references and are in condition for allowance.
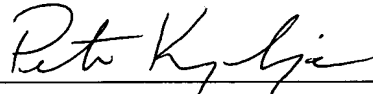
Office Action Section 12 (not labeled) Page 17

Claims 1-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gartner et al (PGPUB No. US 2002/0124047 A1) and further in view of Shelton et al. (US Patent No. 5,954,789).

Gartner et al (published application US 2002/0124047 A1) is co-pending application no. 09/797,784 referenced above. As stated previously, Gartner et al and the present application were commonly owned at the time the invention of the present application was made. Therefore in accordance with MPEP 706.02(l)(2), this is sufficient evidence to disqualify Gartner et al. as prior art and from being used in a rejection under 35 U.S.C. 103(a). Accordingly, the present 103 rejection should be withdrawn.

Conclusion

For the reasons set forth above, **claims 1-25** patentably and unobviously distinguish over the references of record and are now in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

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